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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,590	11/02/2001	Colin John Francis Philip Jones	P66912USO	2981

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136 7590 08/28/2003

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EXAMINER
PHASGE, ARUN S

ART UNIT	PAPER NUMBER
1753	

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/889,590	JONES ET AL.
	Examiner	Art Unit
	Arun S. Phasge	1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30 and 32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30 and 32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Marks et al. (Marks), U.S. Patent 5,458,747.

The Marks patent discloses the claimed substrate mass conditioned (see Abstract). The invention defined in a product-by-process claim is a product, not a process. *In re Bridgeford*, 149 U.S.P.Q. 55 C.C.P.A. (1966). It is the patentability of the product claimed and NOT of the recited process steps, which must be established. *In re Brown*, 173 U.S.P.Q. 685 C.C.P.A. (1972); *In re Wertheim*, 191 U.S.P.Q. 90 C.C.P.A. (1976).

Therefore, since the Marks patent discloses the claimed product, the claims are anticipated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-14 and 17-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al. (Marks), U.S. Patent 5,458,747 in view of Griffith et al. (Griffith), U.S. Patent 5,584,980.

Marks discloses the claimed method and apparatus comprising using an electrokinetic electrode and a further conducting element, the conducting elements located with the substrate mass including the electrolyte therebetween,

and a supply system associated with one of the conducting elements to introduce conditioning materials to treat soil (see abstract and claims 1-19). The reference further disclose the same types of substrate (abstract), reversal of polarity (fig 14), conditioning materials (see 5 and 6) and the evacuation and supply system figures 1-13).

The Marks patent does not disclose that one of the electrodes comprises an electrokinetic geosynthetic structure comprising geosynthetic material. The Griffith patent is cited to show that the use of geosynthetic material as electrokinetic geosynthetic structures (see columns 11 and 12). Therefore, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the disclosure of the Marks patent with the teachings of Griffith, because the Griffith patent teaches that such use of the geosynthetic structures as electrokinetic electrodes produce some improved results.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marks in view of Griffith as applied to claims above, and further in view of Acar et al. (Acar), U.S. Patent 5,616,235.

The Marks patent does not disclose the addition of cohesion inducing material. The Acar patent is cited to show the addition of cohesion inducing material to stabilize soil (see abstract and claims 1-9). Consequently, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the disclosure of the Marks patent in view of the Acar patent, because the Acar patent teaches that electrokinetic soil treatment can be used to stabilize soils.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marks in view of Griffith as applied to claims above, and further in view of Doring, U.S. Patent 5,738,778.

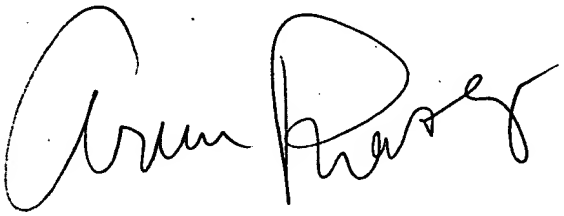
The Marks patent does not disclose the use of current to kill contaminant bacteria in the substrate mass. The Doring patent is cited to show that it is known in the art to treat soils containing bacteria by an electric current to kill the contaminant bacteria (see Abstract and claims 1-45). Therefore, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the disclosure of the Marks patent in view of the teachings of Doring, because the Doring patent teaches that selection of the appropriate current can be used to kill contaminant bacteria.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun S. Phasge whose telephone number is (703) 308-2528. The examiner can normally be reached on MONDAY-THURSDAY, 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (703) 308-3322. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Arun S. Phasge
Primary Examiner
Art Unit 1753

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